

## REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1, 2, 4-7, 9, 10, 12 and 17-27 are now present in this application. Claims 1, 9, 17, 23, 26 and 27 are independent.

Claims 17-27 are added. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

### Drawings

Applicant has not received a Notice of Draftsperson's Patent Drawing Review PTO-948 or other indication of whether or not the formal drawings have been approved by the Draftsperson. Clarification in the next Office Action is respectfully requested.

### Rejection Under 35 U.S.C. § 102

Claims 9, 10 and 12 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,248,946 to Dwek. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicant requests clarification of the statutory basis for this rejection, which is stated as 35 USC §102(a), which states that a person shall be entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for patent.

Applicant's actual filing date is December 21, 2001 and Applicant's effective filing date is December 21, 2000. The Office Action presents no evidence whatsoever that the invention was known or used by others in this country prior to December 21, 2000.

The Dwek patent was not patented or printed until June 10, 2001, which is subsequent to Applicant's effective filing date of December 21, 2000, and Applicant has not been required to submit a translation of its priority document.

Under the circumstances, Applicant will treat the basis of the rejection as 35 USC 102(e).

Dwek discloses a search pane 320a, which includes a search terms entry box 341 and a search parameter selection box 342 (see Dwek Col.6, lines 9-11). The search pane 320 allows a user to browse or search an online music database 114 to locate a particular music selection. The music selection is referenced by song title, artist, album or CD title, or genre (Col.6, lines 15-20). However, no search is performed by file extension, including MP3. The Examiner asserts that Dwek discloses selecting one or more directories including at least one file of a

pre-specified attribute based on the examined attribute information, and displaying the selected directories with their respective hierarchical structures as seen in Fig. 3A and as discussed in column 7, lines 44-50.

However, in column 7, lines 44-50, Dwek discloses (1) that a user, upon browsing the online musical database 114 and locating one or more music selections of interest, may mark the music selection(s) for more easy retrieval in the future; and (2) that the library pane 320b includes a favorites button 351 indicating the location of particular music selections which have been previously marked by the user.

Applicant can find absolutely no disclosure in Dwek of examining the structure of the file data, including an extension of a file recorded on the recording medium for selecting a directory including at least one file having a pre-specified extension based on the examining step, as recited in independent claim 9.

The Office Action also states that Fig. 3A provides all the information needed for displaying a directory, wherein inherently a non-selected directory can be excluded from being displayed, wherein if not selected, it is not displayed.

Applicant respectfully disagrees with this statement.

In the first place, under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to

anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Cont’l Can. Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

So, to the extent that the Office Action states that “inherently a non-selected directory can be excluded,” it is incompatible with the doctrine of inherent disclosure, which requires that something that is inherent must be disclosed.

Dwek does not disclose necessarily excluding non-selected directories from being displayed, as recited. Moreover, for desired music files to be selected by a user in Dwek, those files must be displayed and, there is no disclosure or suggestion in Dwek of not displaying non selected files. Accordingly, Dwek does not anticipate claims 9, 10 and 12.

Claims 10 and 12 depend on independent claim 9, and therefore are patentable at least for the reasons stated with respect to independent claim 9.

Reconsideration and withdrawal of this rejection of claims 9, 10 and 12 under 35 USC §102 as anticipated by Dwek are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1, 2 and 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwek in view of U.S Patent No. 6,396,849 to Sarkissian et al. (Sarkissian). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the

claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. E-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Dwek fails to disclose or suggest examining the structure of the file data, including file attributes, to determine whether or not a directory includes at least one file having a pre-specified attribute on the recording medium and generating a mark for indicating the result of the examining step, as recited in independent claim 1, as amended.

The Office Action also admits that Dwek does not disclose a display showing the marked file and turns to Sarkissian to provide this feature.

However, Sarkissian does not provide either of the aforementioned features, which are absent in Dwek.

Sarkissian, in Fig. 8D, displays a directory of company contacts for a user in the form of a folder and contact tree 198 – see col. 18, lines 8-12, for example.

The Office Action alleges that “section 198, Adeline” is a generated mark associated with the examined directory structure. Applicant respectfully disagrees with this analysis of Sarkissian. Sarkissian fails to disclose or suggest examining the structure of the file data, including file attributes, to determine whether or not a directory includes at least one file having a pre-specified attribute on the recording medium, as recited. Sarkissian merely displays a directory and contents of the subdirectory in a particular format.

Moreover, Sarkissian also fails to disclose or suggest generating a mark for indicating the result of the examining step, as recited. In fact, Applicant respectfully submits that the Office Action has presented nothing but speculation concerning its assertion that “Adeline” is a mark (for indicating the result of the examining step, as recited).

As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection advanced. An



Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Applicant respectfully submits that "Adeline" merely identifies the addressee associated with the file to which it is adjacent, and is not a mark for indicating the result of examining the structure of the file data, including file attributes, to determine whether or not a directory includes at least one file having a pre-specified attribute on the recording medium, as recited.

Claims 2 and 4-6 depend, either directly or indirectly on independent claim 1, thereby containing all of the features recited in claim 1. Accordingly, claims 2 and 4-6 are patentable over Dwek and Sarkissian at least for the reasons that claim 1 is patentable over Dwek in view of Sarkissian, for reasons stated above.

Reconsideration and withdrawal of this rejection of claims 1, 2 and 4-6 under 35 U.S.C. §103(a) are respectfully requested.

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dwek in view of Sarkissian as applied to claims 1-6 and 8 above, and further in view of U.S. Patent No. 6,067,282 to Moriyama. This rejection is respectfully traversed.

Initially, Applicant notes that the reference in this rejection of claims 1 and 6-8 will be considered as a reference to claims 1, 2 and 4-6, which are the claims that are rejected under 35 U.S.C. §103(a) over Dwek in view of Sarkissian, above.

The Office Action further admits that the Dwek-Sarkissian reference combination also fails to disclose a mark on a file, wherein the mark is a number. To remedy this deficiency, the Office Action turns to Moriyama, which shows a directory containing identification numbers.

For reasons discussed above, Dwek and Sarkissian fail to render obvious claim 1, from which claim 7 depends. Because neither Dwek, nor Sarkissian, nor Moriyama discloses or suggests the above-recited features of independent claim 1, even if it were proper to modify Dwek and Sarkissian as suggested, the resulting reference combination would not render claim 7 obvious to one of ordinary skill in the art.

Reconsideration and withdrawal of this rejection of claim 7 under 35 U.S.C. §103(a) are respectfully requested.

### New Claims

Applicant has added claims 17-27. Claims 17-25 are system claims that correspond to method claims 1, 2, 4-7, 9, 10 and 12.

Claims 26 and 27 recite a method and a system, respectively, which are supported, for example, in Figs. 1-5 and throughout the specification that describes Figs. 1-5. Applicant respectfully submits that neither Dwek nor Sarkissian discloses or suggests the features positively recited in new claims 26 and 27.

### Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

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Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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